UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,680	02/07/2001	Isao Okawa	Q62866	3339

7590   07/19/2005

SUGHRUE, MION, ZINN
MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER
LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	09/777,680	OKAWA ET AL.
	Examiner	Art Unit	
	Victor Lesniewski	2152	

THE REPLY FILED 12 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Dung C. Dinh
Primary Examiner

J. O. O.

Continuation of 11. does NOT place the application in condition for allowance because: the applicant's arguments are not persuasive.

The applicant's arguments are in relation to all of the independent claims (claims 1, 6, 11-13, 18, and 23-32) and are directed toward the belief that DeSimone does not disclose the claimed functionality because he does not disclose the functionality at a server device. It is clear that the applicant has misinterpreted DeSimone's disclosure. Take for example the applicant's statement that the citations "teach a completely opposite peer-to-peer system where the server is a mere conduit or message forwarding node" as stated on page 8 of the remarks. DeSimone teaches both a client-server and a peer-to-peer model. The client-server model is used explicitly throughout the disclosure and the peer-to-peer model is considered in some cases as an alternate embodiment. It is inexplicable how the applicant can maintain that DeSimone teaches only a peer-to-peer model when the citations provided for the rejection of every single independent claim include a statement of DeSimone, column 4, lines 39-56. This paragraph summarizes the use of the client-server model as shown in Figure 2A. The applicant is directed to Figure 2A. The alternate embodiment of the peer-to-peer model is shown in Figure 2B. It can be seen that the peer-to-peer model does not include a server, thus making it "peer-to-peer" and thus obfuscating the applicant's remark that the peer-to-peer model includes a server that is a message forwarding node.

Regarding the statement on page 3 of the remarks that it is clear that "DeSimone places the pre-agreed security or interest criteria, as well as processing for such criteria in the receiving local clients," the applicant is directed again to column 15, lines 20-27. This paragraph refers to the model of Figure 2A. This paragraph explicitly states that servers process and route messages, not the receiving local clients. The following paragraph refers to the peer-to-peer model of Figure 2B and provides additional details on message handling. Although, this paragraph relates to the peer-to-peer model, it is noted that the message handling discussed would take place at the server in the cllient-server model.

Similarly, regarding the statement on page 4 of the remarks that DeSimone's intention is "to have control processing resident in the client devices rather than the server," it is again noted that DeSimone discloses two models. It is maintained that the "activity concenring conversion of identifiers" occurs at the server in the client-server model of Figure 2A.

Similarly, regarding the statement on page 7 of the remarks that DeSimone "relies upon activity at the client device, not the server, for selection and initiation of a chat," it is maintained that DeSimone discloses chat processing, including selection and initiation as claimed, at the server in the client-server model.

Regarding the statement on page 7 of the remarks that "DeSimone at col. 6 line40-col. 8, ine 57 does not teach that the server initiates the communication," the applicant is redirected to the stated passage. The applicant's statement is clearly incorrect as this entire passage relates to the client-server model of Figure 2A. It is maintained that DeSimone meets the claim limitations as previously cited for processing at the server device. For example, this passage explicitly states that the SERVER parses and processes chat messages according to the pseudo code shown in column 7.

Regarding the applicant's arguments on page 8 of the remarks that the combination of DeSimone and Grimm is based on hindsight reasoning, it is maintained that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and thus is not based on hindsight reasoning. The applicant's argument is based on the premise that one of ordinary skill would not combine the systems because DeSimone discloses a peer-to-peer model while Grimm discloses a client-server model. It has been shown above that DeSimone does in fact disclose a client-server model, and thus the applicant's argument is refuted. The applicant is further directed to the response to argument 5, paragraphs 25 and 26, of the final action (mailed 4/15/2005) for further detail.

Claims 1-32 remain rejected as discussed in the final action (mailed 4/15/2005).